

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TAKAYOSHI ENDO and TOSHIAKI OKABE

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Appeal No. 2000-2163  
Application No. 08/922,521

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HEARD: April 3, 2001

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Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 6, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of press-connecting a coated electric wire with a press-connecting terminal (claims 1-2) and an apparatus for press-connecting a coated electric wire with a press-connecting terminal (claims 3-6). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art of record relied upon by the examiner in rejecting the appealed claims is:

Keen et al. (Keen)	4,107,838	Aug. 22,
1978		

In addition, the examiner also relied upon the appellants' admission of prior art (specification, page 1, line 7 to page 4, line 2; Figures 5-11) relating to a method of and apparatus for press-connecting a coated electric wire with a press-connecting terminal (Admitted Prior Art).

Claims 1 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Keen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted

rejection, we make reference to the final rejection (Paper No. 4, mailed January 19, 1999) and the answer (Paper No. 13, mailed March 22, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 12, filed December 23, 1999) and reply brief (Paper No. 14, filed May 11, 2000) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 6 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of

obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 1 differs from the Admitted Prior Art by reciting the following heating step:

before the coated electric wire is press-connected with the press-connecting terminal, the coating portion of the coated electric wire is heated and softened so that a force necessary for pressing the coated electric wire into the notched slot [of the press-connecting terminal] is reduced to be not larger than a predetermined value, wherein the heated and softened areas of the coating portion of the coated electric wire remain on the coated electric wire as it is forced into the press-connecting terminal.

Claim 3 differs from the Admitted Prior Art by reciting:

heating means for heating and softening the coating portion of the coated electric wire so that a force necessary for pressing the coated electric wire into the notched slot [of the press-connecting terminal] is

reduced to be not larger than a predetermined value before the coated electric wire is press-connected with the pressconnecting terminal, wherein the heated and softened areas of the coating portion of the coated electric wire remain on the coated electric wire as it is forced into the press-connecting terminal.

The appellants argue that the applied prior art does not suggest the claimed subject matter. Specifically, the appellants argue that the heating step of claim 1 and the heating means of claim 3 is not taught or suggested by the applied prior art. We agree.

Keen teaches the use of an electrical heat coil 56 to soften a narrow annular section 32JA of a cable jacket 32J, as shown in Figure 7, to permit desheathing of leading portion 32JLE of the cable jacket to expose cable wires 31 of the cable 32 for connection of the exposed wires to their respective terminals 33TG or 33TS in cable connector plug 33. Keen does not teach or suggest heating and softening the coating portion of a coated electric wire so that a force necessary for pressing the coated electric wire into a notched slot of a press-connecting terminal is reduced to be not

larger than a predetermined value before the coated electric wire is press-connected with the pressconnecting terminal, wherein the heated and softened areas of the coating portion of the coated electric wire remain on the coated electric wire as it is forced into the press-connecting terminal. Thus, we see no motivation in the applied prior art for a person having ordinary skill in the art at the time the invention was made to have modified the Admitted Prior Art to arrive at the method of claim 1 or the apparatus of claim 3. At best, the combined teachings of the applied prior art would have suggested desheathing the coated electric wire of the Admitted Prior Art as taught by Keen prior to insertion of the wire into the press-connecting terminal.

In our view, the only suggestion for modifying the Admitted Prior Art in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C.

§ 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 to 6.

CONCLUSION

To summarize, the decision of the examiner to reject  
claims 1 to 6 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	



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